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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,729	09/12/2007	Errol Drew	DELTA-102J	3110
32488	7590	01/12/2009	EXAMINER	
Iandiorio Teska & Coleman 260 Bear Hill Road Waltham, MA 02451			MACARTHUR, VICTOR L	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/591,729	Applicant(s) DREW ET AL.	
	Examiner VICTOR MACARTHUR	Art Unit 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/1/2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/2/2007</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

The drawings are objected to for the following:

- The drawings should not refer to "WO 2005/084338" or "PCT/US2005/000671".

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Corrected drawing sheets in compliance with 37 CFR 1.84 and 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the

Art Unit: 3679

applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4-13, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Doyle (U.S. Patent 2,788,234).

The prior art figures clearly disclose applicant's claimed structure.

Claims 3 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Proctor (U.S. Patent 1,971,200).

The prior art figures clearly disclose applicant's claimed structure.

Claims 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin (U.S. Patent 617,536).

The prior art figures clearly disclose applicant's claimed structure.

Art Unit: 3679

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15 and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle (U.S. Patent 2,788,234).

Claim 15. Doyle does not expressly state that the transverse stabilizer is secured to the first portion by an aluminum weld. However:

- The specific method of forming is not germane to the issue of patentability of the device itself. See MPEP § 2113. It is well established by case law that it is the patentability of the product that is to be determined even though such claims are limited and defined by process steps. See *In re Thorpe et al*, 227 USPQ 964 (CAFC 1985). Therefore, the limitation “weld” has been given only limited patentable weight.
- The examiner takes **OFFICIAL NOTICE** that it is extremely well known in the beam joint art to use aluminum welds to join elements for the benefit of reducing weight.
- It has generally been recognized that selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

Art Unit: 3679

- Furthermore, the applicant has failed set forth any criticality to the limitations. That is to say that combining what was known in the art would only produce results that are predictable from what was known about the art. Wherein a specific limitation has no criticality, case law can be relied upon as the sole rationale in an obviousness rejection. See MPEP 2144.04. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to secure the transverse stabilizer to the first portion by an aluminum weld, for the purpose of saving weight and further since the limitation has no criticality and has thus been established by the case law cited above to be an obvious design consideration within the skill of the art.

Claim 16. Doyle does not expressly state that the transverse stabilizer is formed of a material different from the first beveled face. However:

- The examiner takes **OFFICIAL NOTICE** that it is extremely well known in the art to construct portions of beams from different materials.
- It has generally been recognized that selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).
- Furthermore, the applicant has failed set forth any criticality to the limitations. That is to say that combining what was known in the art would only produce results that are predictable from what was known about the art. Wherein a specific limitation has no criticality, case law can be relied upon as the sole rationale in an obviousness rejection. See MPEP 2144.04.

Art Unit: 3679

- Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to form the stabilizer and beveled face from different materials since the limitation has no criticality and has thus been established by the case law cited above to be an obvious design consideration within the skill of the art.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (U.S. Patent 617,536) in view of Doyle (U.S. Patent 2,788,234).

Claim 21. Martin does not expressly state that the beveled faces (beveled faces of J and I¹ that contact one another) extend across the full cross-sections of the first and second portions. However:

- Doyle teaches beveled faces (38, 39) that extend across full cross-sections of the first and second portions.
- One of ordinary skill in the art would immediately recognize that the Doyle faces produce a stronger connection than those of Martin since the Doyle faces are wider (across the full cross-sections) and thus present more contact area.
- It has generally been recognized that the optimization of proportions in a prior art device is a design consideration within the skill of the art. In re Reese, 290 F.2d 839, 129 USPQ 402 (CCPA 1961).
- Furthermore, the applicant has failed set forth any criticality to the limitations. That is to say that combining what was known in the art would only produce results that are predictable from what was already known about the art. Wherein a specific

Art Unit: 3679

limitation has no criticality, case law can be relied upon as the sole rationale in an obviousness rejection. See MPEP 2144.04.

- Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to wider faces that extend across full cross-sections of the portions, as taught by Doyle, for the purpose of producing a stronger joint, and since the limitation has no criticality and has thus been established by the case law cited above to be an obvious design consideration within the skill of the art.

Note to Applicant Regarding Obviousness under 35 USC § 103

In order to overcome the above obviousness rejections above, applicant must show evidence of unexpected results which establish criticality in the limitations.

- Article I, Clause 8 of the United States Constitution clearly states "The Congress shall have Power... **to promote the progress of science and useful arts**, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." (Emphasis added). Accordingly, patents can **only** be issued to the end of promoting science and the useful arts; *Kendall v. Winsor*, 62 U.S. (21 How.) 322, 328 (1859); *A. & P. Co. v. Supermarket Equipment Corp.*, 340 U.S. 147 (1950).
- Promotion of Science and the useful arts requires "more ingenuity than the work of a mechanic skilled in the art"; *Sinclair Co. v. Interchemical Corp.*, 325 U.S. 327, 330 (1945); *Marconi Wireless Co. v. United States*, 320 U.S. 1 (1943).

Art Unit: 3679

- Promotion of Science and the useful arts requires that inventions consisting of accumulations of old devices be given protection "only when the whole in some way exceeds the sum of its parts"; *A.&P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147 (1950).
- Underlying the constitutional tests and congressional conditions for patentability is the balancing of two interests-- the interest of the public in being protected against monopolies and in having ready access to and use of new items; versus the interest of the country, as a whole (not just inventors), in encouraging invention by rewarding creative persons for their innovations. Accordingly, patents can **never** be issued for ordinary inventions with predictable results. "[T]he results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U.S. Const., Art. I, section 8, cl.8." *In re KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).
- Accordingly, inventions are constitutionally **NOT** patentable for trivial details that lack criticality (unexpected results) since such random alterations would be expected in the ordinary progress of technology. "It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufacturers. Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of

Art Unit: 3679

improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country, without contributing anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith.” *Atlantic Works v. Brady*, 107 U.S. 192, 200 (1882); *A. & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147 (1950).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 3679

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

January 12, 2009

/Victor MacArthur/
Primary Examiner, Art Unit 3679